***THIS OPINION WAS NOT WRITTEN FOR PUBLICATION***

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

TONY L. WHISENANT

Junior Party[1]

v.

RUSSELL R. WAGNER

Senior Party[2]

_____

Interference No. 103,467

_____

[1] Application Serial No. 08/016,148, filed February 5, 1993.

[2] Patent 5,223,861, granted June 29, 1993, based on Application Serial No. 07/852,404, filed March 16, 1992.

Before CALVERT, PATE and HANLON, ***Administrative Patent Judges***.

PATE, ***Administrative Patent Judge***.

***FINAL DECISION UNDER 37 CFR §1.658***

This is a final decision in Interference No. 103,467. The involved junior party application is Serial No. 08/016,148 with Tony L. Whisenant as sole inventor. The involved senior party patent is Patent No. 5,223,861 to Russell R. Wagner as sole inventor. The junior party application is not assigned.

The subject matter of the interference is an eyeglass frame with a screwdriver stored inside. The count in inter- ference reads as follows:

***Count 1***

An eyeglass frame comprising:

(a) a front rim;

(b) a first temple arm or leg comprising a front section including a longitudinal bore, and comprising a rear section including a longitudinal screwdriver blade adapted for insertion into said bore, wherein said front section is hingedly connected, by means of a first hinge, to said front rim;

(c) a second temple arm or leg hingedly connected, by means of a second hinge, to said front rim; and

(d) means for coupling said front section to said rear section of the first temple arm.

The claims of the parties that correspond to the count are:

Whisenant Claims 1-3, 5-9, and 11-13

Wagner Claims 1-3

***Background and Issues to be Decided***

The interference was declared September 20, 1994. However, the motion period was suspended when it became apparent that neither the Patent and Trademark Office nor the senior party's attorney of record could locate a current address for the senior party inventor. After the senior party inventor's address was located through on-line searching, the interference was resumed.

The senior party has filed no papers and therefore stands on his effective filing date. The sole issue at final hearing is whether the junior party can antedate the senior

party's effective filing date and thus win the priority contest.

The junior party filed a main brief at final hearing and has waived oral hearing. Accordingly, we move to a consideration of the junior party's priority evidence.

***The Junior Party's Priority Case***

As the junior party in an interference between co-pending applications, junior party Whisenant bears the burden of proving priority by a preponderance of the evidence. ***See Cooper v. Goldfarb***, 154 F.3d 1321, 1326, 47 USPQ2d 1896, 1900 (Fed. Cir. 1998)(***quoting Scott v. Finney,*** 34 F.3d 1058, 1061, 32 USPQ2d 1115, 1117 (Fed. Cir. 1994)).

For his evidence of priority, Whisenant is relying on a reduction to practice before the senior party's effective filing date. The evidence consists of declarations and an exhibit, the exhibit being a pair of eyeglasses said to be within the scope of the count. The following represents our findings with respect to this evidence.

In March 1992, the junior party inventor was stationed in the middle east on duty with the United States Air Force. WR2; WR6; WR8; WR12. Prior to March 16, 1992, the

junior party conceived of a solution to the problem of never having a miniature screwdriver handy when the hinge screw of his glasses needed tightening. WR2; WR8; WR12. He communicated this idea over the phone to his wife Hayley on several occasions prior to March 16, 1992. WR6.

Before March 16, 1992, the junior party constructed a prototype of the invention. WR2; WR8; WR12. The prototype is of record as the junior party exhibit. By testimony (WR 2; WR8; WR12) and by our own inspection, we deem the prototype to be subject matter within the scope of the count. The prototype was used for several months after construction. WR3; WR9; WR13. This use was prior to March 16, 1992. WR3; WR9; WR13.

Priority, conception, and reduction to practice are questions of law which are based on subsidiary factual findings. ***See Hybritech Inc. v. Monoclonal Antibodies, Inc.***, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986), ***cert. denied***, 480 U.S. 947 (1987). A reduction to practice can be

either a constructive reduction to practice, which occurs when a patent application is filed, or an actual reduction to practice. ***See Hybritech***, 802 F.2d at 1376, 231 USPQ at 87. In order to establish an actual reduction to practice, the inventor must prove that:

(1) he constructed an embodiment or performed a process that met all the limitations of the interference count; and (2) he determined that the invention would work for its intended purpose. ***See UMC Elecs. Co. v. United States,*** 816 F.2d 647, 652, 2 USPQ2d 1465, 1468 (Fed. Cir. 1987), ***cert. denied***, 484 U.S. 1025 (1988) ("[T]here cannot be a reduction to practice of the invention . . . without a physical embodiment which includes all limitations of the claim."); ***Estee Lauder Inc. v. L'Oreal S.A.,*** 129 F.3d 588, 593, 44 USPQ2d 1610, 1614 (Fed. Cir. 1997) ("[A] reduction to practice does not occur until the inventor has determined that the invention will work for its intended purpose."). Depending on the character of the invention and the problem it solves, determining that the invention will work for

its intended purpose may require testing. ***See Mahurkar v. C.R. Bard Inc.,*** 79 F.3d 1572, 1578, 38 USPQ2d 1288, 1291 (Fed. Cir. 1996). When testing is necessary, the embodiment relied upon as evidence of priority must actually work for its intended purpose. ***See Scott,*** 34 F.3d at 1061, 32 USPQ2d at 1117.

When an inventor's testimony merely places acts within a stated time period, the inventor has not established a date for his activities earlier than the last day of the period. ***Oka v. Youssefyeh,*** 849 F.2d 581, 584, 7 USPQ2d 1169, 1172 (Fed. Cir. 1988). The junior party may rely on inventive acts in Bahrain by virtue of 35 U.S.C. § 104. Therefore, in accordance with our above-noted factual findings, we credit the junior party with an actual reduction to practice as of March 15, 1992. Junior party has proven priority of invention by antedating the senior party’s effective filing date. We enter judgment in favor of the junior party.

***Judgment***

Judgment in Interference No. 103,467 is entered against Russell R. Wagner, the senior party. Russell R.

Wagner is not entitled to his patent claims 1-3, which claims correspond to the count in interference. Judgment is entered in favor of Tony L. Whisenant, the junior party. Tony L. Whisenant is entitled to

a patent containing claims 1-3, 5-9, and 11-13, which claims correspond to the count in interference.

IAN A. CALVERT )
Administrative Patent Judge )
)
)
) BOARD OF PATENT
WILLIAM F. PATE, III ) APPEALS AND
Administrative Patent Judge ) INTERFERENCES
)
)
)
ADRIENE LEPIANE HANLON )
Administrative Patent Judge )

WFP:psb

Interference No. 103,467

Counsel for Junior Party Whisenant:

Antonio R. Curando et al.
2929 E. Broadway Boulevard
Tuscon, AZ  85716

Counsel for Senior Party Wagner:

Law Offices of E. Michael Combs
7208 Milestone Drive
Huntsville, AL  35802